

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

GENLYTE THOMAS GROUP LLC,
a Delaware Limited Liability Company
Plaintiff,

v.

ARCHITECTURAL LIGHTING SYSTEMS,
a division of ARCH LIGHTING GROUP, a
Rhode Island Corporation

Defendant.

Civil Action No. 05-CV-10945 WGY

**PLAINTIFF'S MOTION IN LIMINE
TO EXCLUDE TESTIMONY REGARDING
PLAINTIFF'S COMMERCIAL EMBODIMENT OF U.S. PATENT No. 5,238.254**

Plaintiff, Genlyte Thomas Group LLC ("Genlyte"), by counsel, submits this Motion in Limine to exclude at the trial of this cause, any and all testimony regarding or relating to Genlyte's commercial embodiment of the patent-in-suit, U.S. Patent No. 5,238,254 ("the '254 Patent"), namely Genlyte's MD*4 and MD Coffe luminaries.

As grounds for this motion, Genlyte states that the papers of Defendant indicate that it will attempt to show it does not infringe the '254 Patent by reference to the design of Genlyte's commercial embodiments produced under the '254 Patent, particularly the MD*4. However, Federal Circuit precedent establishes that, for infringement analysis, it is improper to compare the accused device to the patent holder's commercial embodiment. *See e.g., Amgen, Inc. v. Hoescht Marion Roussel, Inc.*, 314 F.3d 1313, 1347 (Fed. Cir. 2003)("cardinal principle that the accused device must be compared to the claims rather than to a preferred or commercial embodiment"); *Allen Eng. Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1351 (Fed. Cir. 2002)("Infringement is determined by comparing the accused devices not with products made by the patentee but with the

claims of the patent as properly construed”); *Johnson & Johnson Assoc., Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046 (Fed. Cir. *en banc* 2002)(“The law of infringement compares the accused product with the claims as construed by the court. Infringement, either literally or under the doctrine of equivalents, does not arise by comparing the accused product ‘with a preferred embodiment described in the specification, or with a commercialized embodiment of the patentee’”, citing *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121); and *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1423 (“it is error for a court to compare in its infringement analysis the accused product or process with the patentee’s commercial embodiment or other version of the product or process; the only proper comparison is with the claims of the patent”).

Thus, a motion in limine precluding testimony relating to Genlyte’s commercial products made under the ‘254 Patent is warranted.

Respectfully submitted,

/s/ Kevin Gannon
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*Counsel for Plaintiff, Genlyte Thomas
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Certificate of Service

I hereby certify that this document(s) filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and paper copies will be sent to those indicated as non registered participants on this 19th day of January, 2007.

/s/ Kevin Gannon
Counsel for Plaintiff, Genlyte Thomas Group LLC

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Order Granting

**PLAINTIFF'S MOTION IN LIMINE TO EXCLUDE TESTIMONY
REGARDING COMMERCIAL EMBODIMENTS OF U.S. PATENT NO. 5,238,254**

On motion of Plaintiff, Genlyte Thomas Group LLC ("Genlyte") to exclude at the trial of this cause, any and all testimony regarding or relating to commercial embodiments made or sold by Genlyte under the patent-in-suit, U.S. Patent No. 5,238,254 ("the '254 Patent"), and the Court having considered said motion and any response thereto, and after reviewing the Record in this case, and being sufficiently advised,

IT IS ORDERED that Plaintiff's motion is granted. IT IS FURTHER ORDERED that no testimony may be proffered, adduced or accepted relating to any commercial embodiment of the '254 Patent, including but not limited to Genlyte's MD*4 and MD Coffe products.

SO ORDERED THIS ____ DAY OF JANUARY, 2007.

U.S. District Judge

TENDERED BY:

/s/ Kevin Gannon

James E. Milliman (Pro hac vice)

James R. Higgins, Jr. (Pro hac vice)

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